

**Remarks**

Reconsideration is requested in view of the above amendments and the following remarks. Claims 19-20 and 22-23 are canceled without prejudice. Claim 1 is amended to add the limitation that the roughened surface comprises at least one of a sanded and an acid etched surface. Claim 21 is similarly amended to add the limitation that the roughening process comprises at least one of sanding and acid-etching. These limitations are supported by the disclosure, for example at page 3, lines 13-16. No new matter has been added. Claims 1-18, 21, and 24-25 are pending in the application.

Claims 1, 3, 6, 8-10, 13-18, 21, and 24-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by CH 237277. Applicant respectfully traverses the rejection.

A file in accordance with claim 1 comprises a body with first and second sides, first and second edges, a first end, and at least one abrading surface, all of which are formed of a single, integral stratum of glass. In addition, as amended, claim 1 recites that the abrading surface of the file is a sanded and/or acid-etched surface.

Similarly, claim 21 recites a method of making a file, wherein a glass body is roughened by sanding and/or acid-etching to produce at least one abrading surface.

In contrast, CH 237277 discloses a file made from a vitreous material, such as glass, with teeth cut into it. Applicant emphasizes the clear and exclusive disclosure of teeth in CH 237277. Applicant references page 1, paragraph 4 of the translation, wherein it is disclosed that “a series of parallel teeth” are cut into a sheet of glass. Similarly in the page 2, paragraph 1 (continued from page 1) it is disclosed that “file teeth are cut” into a layer of enamel.

Applicant respectfully submits that an acid-etched or sanded surface is structurally distinct from and has functional advantages over a series of cut teeth.

With regard to structure, Applicant notes for example that a sanded or acid-etched surface has an essentially random texture; That is, the surface has a more or less random structure of peaks and valleys. In contrast, cut teeth as disclosed in CH 237277 have an orderly, parallel linear arrangement.

With regard to function, Applicant respectfully points out that a series of parallel cut teeth as disclosed in CH 237277 comprises a series of grooves cut into the surface of the file. However, as is well known, glass is weakened and easily broken along cut lines; indeed, scoring is widely used as a method of deliberately breaking glass in a controlled fashion. Thus, each groove constitutes a potential fracture flaw in the file.

In addition, Applicant respectfully submits that sanding and acid etching are convenient methods for producing an abrasive surface on glass, as compared with cutting teeth. Applicant notes that it is disclosed, for example at page 1, paragraph 4 of the translation of CH 237277 that the teeth are cut with a grinding wheel. Applicant respectfully submits that in such a case, the cutting operation requires a relatively high degree of precision. Such a precision machining step is difficult and time-consuming, and is not easily adapted to mass production. In addition, each of the parallel cuts is a point of potential fracture, as noted above, and thus special care and/or special precautions would likely be needed in order to prevent a high loss rate during manufacture.

CH 237277 does not disclose or even suggest any abrasive structure other than teeth. In particular, CH 237277 does not disclose or suggest a sanded or acid-etched abrading surface. Similarly, CH 237277 does not disclose or suggest sanding or acid-etching a glass body in order to produce an abrading surface.

As the claimed invention according to claims 1 and 21 comprises structure and functions neither disclosed nor suggested by CH 237277, Applicant respectfully submits that claims 1 and 21 are not anticipated by CH 237277. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 3, 6, 8-10, and 13-18 depend from claim 1, and incorporate the limitations thereof. Claims 24-25 depend from claim 21, and likewise incorporate the limitations thereof. The preceding remarks apply equally to these dependent claims, and Applicant respectfully submits that separate arguments need not be presented in support of them at this time. Applicant does not concede the correctness of the rejection, and reserves the right to present additional arguments.

Claims 2, 4, 5, and 7 are rejected under 35 U.S.C. § 103(a) as being anticipated by CH 237277 in view of Daley (U.S. Patent No. 6,145,512). Applicant respectfully traverses the rejection.

Claims 2, 4, 5, and 7 depend from claim 1, and incorporate the limitations thereof. Applicant respectfully submits that separate arguments need not be presented in support of these dependent claims at this time. Applicant does not concede the correctness of the rejection, and reserves the right to present additional arguments.

Furthermore, Applicant respectfully submits that neither of CH 237277 or Daley, either alone or in combination, discloses or suggests a file as recited by the rejected claims, or as recited by claim 1, from which they depend.

The rejection relies upon CH 237277 to disclose the general structure of a file, and relies upon Daley to disclose an oblong shape and beveled edges. However, as argued above, Applicant respectfully submits that CH 237277 does not disclose or even suggest an abrading surface of a glass body that is either a sanded surface or an acid-etched surface. Furthermore, even if Pangburn is prior art as characterized, and is suitable for combination with CH 237277, which points Applicant does not concede, Applicant respectfully submits that Daley does not overcome the deficiencies of CH 237277, in that Daley does not disclose or suggest an abrading surface of an integral glass body that is either a sanded surface or an acid-etched surface.

Claim 11 is rejected under 35 U.S.C. § 103(a) as being anticipated by CH 237277 in view of Pangburn (U.S. Patent No. 5,361,786). Applicant respectfully traverses the rejection.

Claim 11 depends from claim 1, and incorporates the limitations thereof. Applicant respectfully submits that separate arguments need not be presented in support of these dependent claims at this time. Applicant does not concede the correctness of the rejection, and reserves the right to present additional arguments.

Furthermore, Applicant respectfully submits that neither of CH 237277 or Pangburn, either alone or in combination, discloses or suggests a file as recited by claim 11, or as recited by claim 1, from which it depends.

The rejection relies upon CH 237277 to disclose the general structure of a file, and relies upon Pangburn to disclose a roughness varying from 10 to 100 microns. However, as argued above, Applicant respectfully submits that CH 237277 does not disclose or even suggest an abrading surface of a glass body that is either a sanded surface or an acid-etched surface. Furthermore, even if Pangburn is prior art as characterized, and is suitable for combination with CH 237277, which points Applicant does not concede, Applicant respectfully submits that Panburn does not overcome the deficiencies of CH 237277, in that Pangburn does not disclose or suggest an abrading surface of an integral glass body that is either a sanded surface or an acid-etched surface.

Claim 12 is rejected under 35 U.S.C. § 103(a) as being anticipated by CH 237277 in view of Tsukamoto (U.S. Patent No. 3,866,618). Applicant respectfully traverses the rejection.

Claim 12 depends from claim 1, and incorporates the limitations thereof. Applicant respectfully submits that separate arguments need not be presented in support of these dependent claims at this time. Applicant does not concede the correctness of the rejection, and reserves the right to present additional arguments.

Furthermore, Applicant respectfully submits that neither of CH 237277 or Tsukamoto, either alone or in combination, discloses or suggests a file as recited by claim 12, or as recited by claim 1, from which it depends.

The rejection relies upon CH 237277 to disclose the general structure of a file, and relies upon Tsukamoto to disclose a V-shaped end. However, as argued above, Applicant respectfully submits that CH 237277 does not disclose or even suggest an abrading surface of a glass body that is either a sanded surface or an acid-etched surface. Furthermore, even if Tsukamoto is prior art as characterized, and is suitable for combination with CH 237277, which points Applicant does not concede, Applicant respectfully submits that Tsukamoto does not overcome the deficiencies of CH 237277, in that Tsukamoto does not disclose or suggest an abrading surface of an integral glass body that is either a sanded surface or an acid-etched surface.

Claims 19 and 23 are rejected under 35 U.S.C. § 103(a) as being anticipated by CH 237277 in view of Bray (U.S. Patent No. ). Applicant respectfully traverses the rejection.

Claims 19 and 23 are canceled herein without prejudice. Applicant does not concede the correctness of the rejection.

Applicant notes that claims 1 and 21 are amended to include limitations similar to those formerly in claims 19 and 23. However, Applicant respectfully submits that claims 1 and 21 would not be obvious from CH 237277 in view of Bray.

As argued above, Applicant respectfully submits that CH 237277 does not disclose or even suggest an abrading surface of a glass body that is either a sanded surface or an acid-etched surface.

In the rejection of claims 19 and 23, Bray is characterized as disclosing a nail file having at least one abraded surface being a sanded surface. Applicant respectfully submits that this

characterization is incorrect given the term “sanded surface” as the term is used within the specification of the claimed invention.

In the claimed invention according to claim 1, a sanded surface is a surface that has been shaped with sand so as to form an abrading surface. The claimed invention discloses, for example at page 2, lines 20-21, that the file “is made from glass roughened on at least part of its surface”. The claimed invention also discloses, for example at page 3, lines 12-13, that “roughness . . . can be produced mechanically, by sanding for example.” Thus, according to the disclosure, the term “sanded surface” is given the meaning of a glass surface that has been roughened by the use of sand. Applicant notes that sanding may be accomplished by various means, e.g. sandblasting.

Similarly, in the claimed invention according to claim 21, sanding is a process wherein the glass is shaped with sand to form an abrading surface.

The rejection relies upon column 4, lines 9-10 of Bray to disclose a sanded surface. However, Applicant respectfully points out that Bray discloses sand paper therein, comprising the layer of abrasive material disclosed at column 2, line 61. Thus, in contrast to the claimed invention, Bray discloses attaching a sheet of paper with sand bonded thereto to a file.

Applicant respectfully submits that a surface that has been sanded is entirely different from a surface to which a layer of sand has been bonded. Similarly, Applicant respectfully submits that a method step of sanding a surface is entirely different from a method step of bonding sand to a surface.

Bray nowhere discloses nor even suggests a surface that is sanded, or a file comprised of a single, integral stratum of glass.

Furthermore, Applicant respectfully submits that the disclosure of Bray teaches away from the claimed invention, for at least the reason that Bray discloses, for example at column 2,

lines 60-61, using a layer of abrasive material that is separate from a long narrow core of aluminum. This is directly opposed to the principles of the claimed invention, wherein the abrading surface, the body, the sides, the edges, and the end are formed of a single, integral stratum of glass.

Applicant respectfully submits that a combination of CH 237277 with Bray would at best result in a glass file with a separate layer of sand or other abrasive material bonded thereto. A combination of CH 237277 with Bray would not result in either a file made of a single, integral stratum of glass, or a sanded abrading surface, as is disclosed and recited by the claimed invention.

As the claimed invention comprises structure neither disclosed nor even suggested by either of CH 237277 with Bray, alone or in combination, Applicant respectfully submits that neither of claims 1 or 21 could be fairly considered to be obvious from CH 237277 in view of Bray.

Claims 20 and 22 are rejected under 35 U.S.C. § 103(a) as being anticipated by CH 237277 in view of Bankier et al. (U.S. Patent No. ). Applicant respectfully traverses the rejection.

Claims 20 and 22 are canceled herein without prejudice. Applicant does not concede the correctness of the rejection.

Applicant notes that claims 1 and 21 are amended to include limitations similar to those formerly in claims 20 and 22. However, Applicant respectfully submits that claims 1 and 21 would not be obvious from CH 237277 in view of Bankier.

As argued above, Applicant respectfully submits that CH 237277 does not disclose or even suggest an abrading surface of a glass body that is either a sanded surface or an acid-etched surface.

In the rejection of claims 20 and 22, Bankier is characterized as disclosing a nail file having at least one abrading surface being an acid-etched surface. Applicant respectfully traverses this characterization.

The claimed invention according to claim 1 comprises a single, integral stratum of glass that has been etched with acid so as to form an abrading surface. The claimed invention discloses, for example at page 2, lines 20-21, that the file "is made from glass roughened on at least part of its surface". The claimed invention also discloses, for example at page 3, lines 10-11, that "a chemical process can be used, such as acid engraving". Thus, according to the disclosure, the term "acid-etched surface" is given the meaning of a glass surface that has been roughened with acid. Applicant emphasizes that it is the glass that is etched.

Similarly, in the claimed invention according to claim 21, the glass is etched with acid to form an abrading surface.

The rejection relies upon column 4, lines 43-48 of Bankier to disclose an acid-etched surface. However, Applicant respectfully points out that the surface Bray discloses acid-etching is disclosed, for example at column 4, lines 33-42, to be a blank with a cured resin coating.

At column 2, lines 51-57, Bankier discloses a file that consists of a strip 14, a multiple layer coating 16 including the resin coating 17 and abrasive granules 18 therein, and a metal strike coating 19.

Thus, column 4, lines 43-48 of Bankier only discloses etching away one layer of many to expose a layer underneath, namely a layer of abrasive granules bonded to the file. Applicant also refers to column 3, lines 3-6, which discloses breaking or wearing the plastic coating to expose the granules.

Applicant respectfully submits that an exposed underlying layer of granules bonded to a surface is entirely different from a surface that has been roughened with acid. Similarly,

Applicant respectfully submits that a method step of acid-etching a glass body is entirely different from a method step of etching away one layer of a multi-layer blank. Furthermore, Applicant respectfully submits that the fact that the granules may be exposed with acid in no way minimizes the structural differences between a layer of bonded granules and an acid-roughened surface of an integral stratum of glass.

Bankier nowhere discloses nor even suggests a surface that is roughened by acid-etching, or a file comprised of a single, integral stratum of glass.

Furthermore, Applicant respectfully submits that the disclosure of Bankier teaches away from the claimed invention, for at least the reason that Bankier discloses, for example at column 2, lines 51-57, that the file is composed of multiple layers of different materials. This is directly opposed to the principles of the claimed invention, wherein the abrading surface, the body, the sides, the edges, and the end are formed of a single, integral stratum of glass.

Applicant respectfully submits that a combination of CH 237277 with Bankier would at best result in a glass file with resin and abrasive granules bonded thereto. A combination of CH 237277 with Bankier would not result in either a file made of a single, integral stratum of glass, or an acid-etched abrading surface, as is disclosed and recited by the claimed invention.

As the claimed invention comprises structure neither disclosed nor even suggested by either of CH 237277 with Bankier, alone or in combination, Applicant respectfully submits that neither of claims 1 or 21 could be fairly considered to be obvious from CH 237277 in view of Bray.

As all matters raised in the Office Action have now been addressed, Applicant respectfully submits that the pending claims are in condition for allowance. Favorable reconsideration is respectfully requested in view of the preceding amendments and remarks.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's primary attorney-of record, John J. Gresens (Reg. No. 33,112) at (612) 371-5265.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
612/332-5300

Date: Aug. 6, 2001

  
John J. Gresens  
Reg. No. 33,112  
JJG/MLL

